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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/744,642	01/26/01	GERS-BARLAG H	BEIERSDORF-K

HM12/0723

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EXAMINER	
YU,G	
ART UNIT	**PAPER NUMBER**
1619	4

DATE MAILED: 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No.	Applicant(s)	
	09/744,642	Gers-Berlag et al.	
	Examiner	Art Unit	
	Gina C Yu	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5, 6, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because the phrase "finely dispersed" renders the claim vague and indefinite. The metes and bounds of the patent protection sought are unclear.

Claim 1 is rejected also because the term "i.e." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim 1 is rejected also because the expression "system of . . . type" renders the claim vague and indefinite. It is understood from the specification that the claimed invention refers to emulsion compositions. However, adding a vague expression an otherwise definite expression extends the scope of the expression so as to render it indefinite.

Claim 1 is rejected also because it is not clear from the specification and the prior art whether the claimed boron nitride is treated or non-treated compounds. The claim language seems to suggest that claimed boron nitride is inherently amphiphilic, whereas the specification discloses otherwise. See spec. 6, line 5 – p. 7, line 4.

Claim 5 is rejected because the term "particularly advantageously" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim 6 is rejected because the term "in particular" in lines 2 and 4 renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim 8 is rejected because the usage of the term "and/or" in Markush language is incorrect. A sample format of the appropriate Markush language is "selected from the group consisting of A, B, C and D."

Claim 1-8 are also objected to because the term "preparations" is not a conventionally used term in composition claims. For the examining purposes under § 103, the term "preparation" is taken as to mean "composition".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (U.S. Pat. No. 5,725,844) in view of Introini (Cosmet. Toiletries, 1997, Vol. 18, No. 3).

Gers-Barlag et al. disclose photoprotective O/W emulsions or hydrodispersions, comprising hydrophobic inorganic pigments, UV filters and other cosmetic ingredients. See abstract; col. 1, line 44 – col. 8, line 49. The compositiosn are essentially emulsifier-free. The reference teaches that, while emulsifier-free compositions may be safer, addition of high quantity of UV filter renders tacky feeling. See col. 2, line 63 – col. 3, line 37. The reference fails to teach adding the boron nitride as required by the instant application.

Introini (3/1997) teaches the use of boron nitride in cosmetic art. The cosmetically beneficial properties of boron nitride, including silky and rich feel, improved spreadability, improved color and adhesion, improved durability and evaporation, are disclosed. See p. 26, col. 1. In the same column the reference also discloses that the boron nitride used in the study is supplied from Advanced Ceramics, which also is a supplier of the boron nitride that may be used in the invention, as applicants disclose in spec. 6, lines 30-34. Introini lacks the teaching of the particle size or amphiphilic characteristic of boron nitride as claimed in the instant application. Although it is not clear from the claimed language whether the boron nitride in claim 1 is treated or untreated, as

mentioned in § 112 rejection above, examiner takes the view that the boron nitride used in Introini article may be the same type of boron nitride in the instant invention, meeting the limitations in the instant claims 5 and 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Berlag et al. by adding boron nitride as suggested by Introini because of the expectation to have successfully eliminated the problem associated with stickiness of the emulsion composition and produced a composition with good lubricating properties, velvety and smooth feel. One skilled in the art would have also expected that composition would evaporate rapidly, absorb oil and dissipate heat, which would be desirable for a sun care cosmetic composition.

(B) Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (U.S. Pat. No. 5,725,844) in view of Inoitrini (Cosmet. Toiletries, 1997, Vol. 18, No. 2).

Gers-Barlag et al. is discussed above. The reference lacks the teaching of adding boron nitride.

Introini (2/1997) teaches water-in-oil compositions for skin care. The cosmetically beneficial properties of boron nitride, including good fluidity, silky feel, rapid evaporation, long durability, and ability to absorb oil and dissipate heat, are disclosed. See p. 71, col. 1. The compositions contain 2% by weight of boron nitride, which meets claim 4. See Tables. The compositions lacks the teaching of the particle size and the amphiphilic property of boron nitride.

Mitchell et al. disclose a pigment composition for make-up composition, which comprise a pigment extender, pigment, and hydrogenated, amphiphilic phospholipid materials. See col. 1, line 45 – col. 5, line 34; claim 1 and 7. They also teach this solution may be dried to obtain a powdered pigment composition. Magnesium silicate and boron nitride are among the disclosed pigment extenders. See col. 2, lines 12 – 20. The size of the pigment extender powder is approximately 4-10 μm, which meets claim 5. See col. 2, lines 22 – 29. The cosmetic composition containing the invention exhibits improved skin adhesion, texture, applicability in various cosmetic compositions and skin treatment. See col. 1, line 57 – col. 2, line 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Barlag et al. by using the boron nitride as taught by Introini because of the expectation to have produced composition with silky and smooth feel and good spreadability while maintaining stability of the composition. One would have been motivated to prepared the composition with boron nitride from the disclosed pigment composition in Mitchell et al. because of expectation that the composition would render good skin adhesion, texture and be applicable to various other cosmetic compositions.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
July 16, 2001

